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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,723	08/09/2000	Nizar Allibhoy	22925-701-6US	5294

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,723

Applicant(s)

ALLIBHOY ET AL.

Examiner

Bunjob Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reviewed; the objections and rejections cited are as stated below.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 (e) as follows:

a. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

b. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-27, of this application. The provision application disclosure failed to support the claim limitation, which regards to forming profile from

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interactive information, updating profile, extracting criteria based on user, administrator and or third party device.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4-17, 20-22 and 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Gardner (U.S. 6,141,694).

6. Regarding claims 1-2, 4-10, 13-17, 20 and 24-27, Gardner discloses a method, apparatus and computer program, hereinafter is a "system", for communication network content, the system includes a WebTV system (Fig. 1-3), which is known of its ability of providing a standard program, e.g., TV program and an enhanced programming, e.g. interactive, or HTML, to its client and user (Col. 3, lines 1-26, lines 55-65); a third party unit (32, Fig. 4A) for monitoring client-server transactions (Fig.7); identifying transactions; extracting information from the transactions based on criteria set by the user, or third party; filtering, i.e., tailoring, the information according the client profile; providing the information to the client, for viewing by its user. Gardner further discloses the system capable of extracting information from client-sever transaction, e.g., user personal data, for updating user activity profile, continuously and periodically (Col. 1, lines 20-42; Col. 6, lines 1-33; Fig. 6; Col.7, lines 15-60; Col.9, lines

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19-29). 7. Regarding claim 21, Gardner discloses unit 32 coupled to receiver 31, for monitoring user activity and for updating user activity profile (Fig. 4A; Col. 6).

7. Regarding claim 22, Gardner discloses an input card 9, a remote device 11 and a keyboard 14 for users input the criteria, which are utilized by unit 32 (Fig. 2 and 4A).

8. Regarding claims 11 and 12, Gardner discloses a WebTV system, i.e., interactive television, in which its contents are constantly substituted, per client request during interaction, thus the feature of substituting enhanced content with a specific enhanced content is inherent feature.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 18-19 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardner (U.S. 6,141,694).

11. Regarding claims Sand 23, Gardner discloses the invention substantially, as claimed in claim 1, but failed to include a network operator for monitoring and setting criteria for extracting transactions information. However, by disclosing a third party unit, for monitoring such activity and extracting information from client-server transaction. Official Notice is taken (see MPEP 2144.03) network operator was notorious in computer networking art at the time of the invention was made, thus substituting or associating the third party unit with network operator, would have

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been obvious to one of ordinary skill in the art at the time of the invention was made to do so, with the motivation to include human intervention within a system.

12. Regarding claims 18-19, Gardner discloses the invention substantially, as claimed in claim 16, but failed to explicitly include a PDA and satellite broadcast system therewith.

Official Notice is taken (see MPEP 2144.03) that PDA and satellite broadcast transmission were notorious and widely utilized in network communication, specially, in WebTV system. Thus, taking advantage from the well-known receiving and transmitting means, e.g., PDA and satellite broadcast system, would have been obvious to one of ordinary skill in the art at the time of the invention was made, with the motivation of expanding content service and enhancing its mobility.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'B. Jaoenchonwanit', with a stylized flourish at the end.

Bunjob Jaoenchonwanit
Primary Examiner
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/bj